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| 09/966,329 | 09/26/2001 | Wolfgang Oelerich | NI 136 | 9453 |

7590 01/14/2005

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| EXAMINER |
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WYSZOMIERSKI, GEORGE P

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| ART UNIT | PAPER NUMBER |
| 1742 | |

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,329

Applicant(s)

OELERICH ET AL.

Examiner

George P Wyszomierski

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20041006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (U.S. Patent 5,864,072).

Kobayashi discloses electrode materials the majority of which comprise Ni, Co, and Mn, and which have an oxygen concentration ranging from 0.2 to 2.0 wt%; see the Examples and Table 1 of Kobayashi.

Kobayashi does not specify the presence of metal oxides of the above-mentioned metals or the amount of any such oxides. The examiner's position is that the oxygen present, being highly reactive with the metals in the Kobayashi materials, is most likely present chiefly in the form of oxides of those metals. Further, the oxide content of the prior art materials (in wt%) would be somewhat greater than their oxygen concentration, i.e. oxygen has a lower molecular weight than any of those metals. It is thus a reasonable assumption that the metal oxide content of the Kobayashi materials would fall within the 1-10 wt% range recited in claim 1.

With respect to claim 13, it is unclear what the precise source of oxygen is in the prior art. However, it appears that the oxygen is either present as an impurity in the starting materials of Kobayashi, or is present in the atmosphere during processing of those materials, or some combination of the two. In the first such case, the oxide would have been formed "by contact with oxygen from elements of the electrode material", and in the second case "by direct oxygen admission", and therefore meets the claimed limitations regarding forming of the oxide in either case.

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Consequently, a prima facie case of obviousness is established between the disclosure of Kobayashi et al. and the presently claimed invention.

3. Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 03-281710.

The '710 reference discloses metalliferous materials for batteries that may include such components as oxides of Co, Ni, or Cu; see the Abstract and examples 6 and 13 from Table 1 of JP '710. The prior art does not specify the amount of oxide in the material as required by the instant claims, and does not disclose the crystalline structure of the material. These differences are not seen as resulting in a patentable distinction between the prior art and the claimed invention because:

a) The oxide amounts as presently claimed include a very broad range, and the materials as claimed would fall within the purview of the materials as disclosed by JP '710. Further, JP '710 includes examples that contain at least one of the specific metal oxides recited in the instant claim.

b) With regard to the crystalline structure of claims 4 and 5, the prior art materials and those of the present invention may be of the same materials produced by substantially the same processes in either case. It is thus a reasonable assumption that the resultant crystalline structures of the respective materials would likewise be the same.

Consequently, a prima facie case of obviousness is established between the disclosure of JP 03-281710 and the presently claimed invention.

4. Claims 1, 2, 4-6, and 8-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S.

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Patent No. 6,752,881 (which issued from Application no. 09/962,859, noted on page 8 of the previous Office Action).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed materials and methods appear to be identical to those of the '881 claims. The intended use of the materials in the present claims is different from that of the '881 claims, but it is unclear how or whether a mere potential future use of a given material could serve to patentably distinguish that material (or a method of making same) from a substantially identical recitation of the material and process steps in the '881 claims.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Applicant amended the present claims on October 6, 2004. That amendment overcomes the previous rejections based upon the Ovshinsky et al. or EP 0184427 disclosures. With respect to Kobayashi et al., the examiner agrees that the amendment overcomes the previous rejection based on 35 USC 102 over this patent, but that the rejection under 35 USC 103 *supra* is now proper.

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Applicant alleges that the materials of JP '710 would not possess the catalytic effect of the instant claims, but provides no evidence in support of this assertion. The examiner's position is that a given material, whether in the prior art or the claimed invention, would possess a catalytic effect based upon its composition and structure.

With respect to the obviousness-type double patenting rejection, Applicant alleges that the present invention relates to electrodes whereas the '881 invention is drawn to hydrogen storage materials. Applicant's arguments do not overcome the rejection because the instant claims are to a material (and methods for making same), which appear to be identical to the corresponding materials and methods in the '881 claims. Any intended use thereof is not seen as patentably defining the present invention over that claimed in the '881 patent.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. Effective October 1, 2003, all patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



GEORGE WYSZOMIERSKI
PRIMARY EXAMINER

GPW
January 13, 2005